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**D E C I S I O N**  
**of 16 March 2004**

**Case Number:** T 0897/03 - 3.3.8

**Application Number:** 92922076.2

**Publication Number:** 0623168

**IPC:** C12N 15/12

**Language of the proceedings:** EN

**Title of invention:**

T cell epitopes of the major allergens from Dermatophagoides  
(house dust mite)

**Applicant:**

IMMULOGIC PHARMACEUTICAL CORPORATION

**Opponent:**

-

**Headword:**

Dermatophagoides allergens/IMMULOGIC PHARMACEUTICAL

**Relevant legal provisions:**

EPC Art. 111(1)  
EPC R. 66(1), 68(2), 67, 86(3)

**Keyword:**

"Decision reasoned in the sense of Rule 68(2) EPC (no)"  
"Substantial procedural violation (yes)"  
"Reimbursement of appeal fee (yes)"

**Decisions cited:**

T 0292/90, T 0522/90, T 0652/97, T 0278/00

**Catchword:**

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Case Number: T 0897/03 - 3.3.8

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.8  
of 16 March 2004

**Appellant:** IMMULOGIC PHARMACEUTICAL CORPORATION  
610 Lincoln Street  
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**Representative:** Lock, Graham James  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 31 January 2003  
refusing European application No. 92922076.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** L. Galligani  
**Members:** M. R. Vega Laso  
S. C. Perryman

## Summary of Facts and Submissions

I. European patent application No. 92 922 076, published as international application WO 93/08279 (EP A 0 623 168) with the title "T cell epitopes of the major allergens from Dermatophagoides (house dust mite)", was refused by the examining division by a decision pursuant to Article 97(1) EPC posted on 31 January 2003.

II. The decision was based on the request then on file, ie claims 1 to 52 as filed on 2 October 2001. The grounds for the decision read:

"In the communication(s) dated 23.05.2000, 30.05.2001, 31.10.2002 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 02.01.2003.

The application must therefore be refused."

III. In a first communication dated 23.05.2000, the examining division had objected to claim 1 as then on file on the grounds of lack of unity (Article 82 EPC), arguing that the common concept that linked the claimed peptides was considered to be implicitly anticipated by the prior art. Furthermore, referring to the international preliminary examination report

established for the application, the examining division stated that the deficiencies mentioned in said report would give rise to objections under the corresponding provisions of the EPC.

- IV. From the reasoning given in the preceding communication in support of the objection of lack of unity the appellant inferred that, though not having raised a formal objection in this respect, the examining division considered that the subject-matter of at least claim 1 contravened Article 54 EPC. Therefore, in its subsequent response the appellant addressed the issues of lack of unity and lack of novelty. Amended claims 1 to 31 which allegedly overcame these objections were filed with the response. Amended claim 1 included a disclaimer.
- V. In a subsequent communication dated 30 May 2001, the examining division maintained the objection of lack of unity, explicitly raised the objection of lack of novelty, and raised new objections under Articles 123(2), 84 and 56 EPC.
- VI. Thereafter, the appellant submitted a new set of claims (claims 1 to 52) in which method claims 1 to 21 had been introduced. Furthermore, claims 22 to 42 of the new request, which corresponded broadly to previous claims 1 to 18 and 29 to 31, had been amended to omit various terms previously objected to under Article 84 EPC, as well as the disclaimer in claim 1, which disclaimer had caused the objection on the grounds of Article 123(2) EPC to be raised. The appellant requested oral proceedings.

- VII. In a third communication dated 31 October 2002, which was attached to the summons to oral proceedings, the examining division, exercising its discretion under Rule 86(3) EPC, refused to accept the newly introduced method claims into the proceedings, on the grounds that they were filed 10 years after the filing date of the application and did not represent a serious attempt to overcome objections previously raised. With respect to the remaining claims 22 to 52, the examining division maintained the objections raised under Articles 82, 84 and 56 EPC providing additional argumentative support, and raised new objections on the grounds of Article 83 and Rule 29(2) EPC.
- VIII. Upon receipt of the summons and the attached communication the appellant withdrew its request for oral proceedings and requested a formal written decision on the case. The examining division then issued a decision pursuant to Article 97(1) EPC (see sections I and II *supra*).
- IX. On 31 March 2003 the appellant lodged an appeal against the decision of the examining division and paid the appeal fee. With the statement of grounds of appeal filed on 10 June 2003 the appellant submitted as a new main request claims 1 to 52 corresponding essentially to the claims 1 to 52 on which the decision of the examining division was based, and, additionally, new first and second auxiliary requests.
- X. In the statement of grounds of appeal the appellant maintained that its submissions in reply to the communications issued by the examining division on 23 May 2000 and 30 May 2001 contained detailed comments

on all the objections raised by the examining division, and that the amended claims filed with these submissions clearly addressed said objections. The appellant further stated that, as the final decision of the examining division indicated that the application was refused because no comments or amendments had been filed in reply to the last communication dated 31 October 2002, it understood that the sole objections outstanding would be those identified in said communication. The appellant put forward arguments addressing these specific objections and, in the event that its understanding of the reasons for the appealed decision was not correct, requested the board to identify which of the objections raised by the examining division were outstanding.

- XI. The appellant requested that the decision of the examining division be set aside and the case remitted to the first instance with the order to grant a patent on the basis of the main request or, subsidiarily, one of the first or second auxiliary requests. In the event that the board intended to dismiss the appeal, the appellant requested that oral proceedings be held.

### **Reasons for the Decision**

1. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC, and is admissible.
2. The purpose of an appeal procedure is mainly to give a party adversely affected by a decision of the first instance the possibility of challenging the decision on its merits. In order for a party to a procedure to be

able to examine whether a decision taken by a department of the first instance was justified or not, decisions open to appeal must be reasoned. This principle, which is reflected in Rule 68(2) of the European Patent Convention, is of fundamental importance for ensuring the fairness of a procedure (see T 652/97 of 16 June 1999).

3. Rule 68(2) EPC states that decisions of the European Patent Office which are open to appeal must be reasoned. Pursuant to the established jurisprudence of the Boards of Appeal this means that a decision of any of the departments of the first instance of the European Patent Office must contain, in logical sequence, those arguments which justify the tenor. The grounds upon which a decision is based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail **in the decision** (see T 0278/00, OJ 2003, 546).
4. In the present case, the decision under appeal neither specifies the grounds upon which it is based, nor contains any facts, evidence or arguments that justify the refusal of the application. The appealed decision contains solely a reference to reasons given in three communications issued in the course of the examination of the application, each of these communications having as basis a different set of claims filed by the appellant in response to the respective preceding communication.
5. The fact that the decision under appeal does not contain any specific reasons, but merely refers to various communications issued by the examining division

has the consequence that, in order for the board to be in the position of reviewing the decision under appeal, it would have to examine each of the cited communications for facts, evidence and arguments that may support the refusal of the application. Moreover, due to the numerous objections raised with respect to different sets of claims and the partly inconsistent reasoning given in the communications referred to in the decision, the decisive reasons for the refusal of the application remain unclear both to the board and, as it can be inferred from its request to identify the outstanding issues, to the appellant. The decision under appeal thus leaves it to the board and the appellant to speculate as to which of the reasons given by the examining division in its communications might be essential to the decision to refuse the application.

6. This is at odds with the well established principle that, for a decision to be reasoned within the meaning of Rule 68(2) EPC, it must be self-contained, ie it must include all and each of the facts, evidence and arguments that are essential to the decision, and the chain of reasoning in the decision must be complete (see T 652/97 and T 278/00, cited above). For the reasons given above, the decision under appeal fails to meet these requirements.
  
7. In the board's judgment, the *de facto* absence of reasoning in the appealed decision amounts to a substantial procedural violation. Such a procedural violation requires, in line with other decisions of the boards of appeal (eg T 292/90 of 16 November 1992; T 522/90 of 8 September 1993 and T 278/00, cited above), that the decision under appeal be set aside and the



case remitted to the first instance in application of Article 111(1) EPC. Exercising its discretion under Rule 86(3) EPC which is applicable in virtue of Rule 66(1) EPC, the board decides to admit into the proceedings the three sets of claims according to the main request and the two auxiliary requests as filed by the appellant with the statement of grounds of appeal on 10 June 2003. The case is thus remitted to the examining division for further prosecution on this basis.

8. The appeal is deemed to be allowable. Although the appellant has not requested reimbursement of the appeal fee, the board considers it to be equitable by reason of the substantial procedural violation incurred to reimburse the fee (Rule 67 EPC). Since the appellant's request that the appealed decision be set aside has been granted, there is no need to hold oral proceedings before the board in accordance with its subsidiary request.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 52 of the main request and the auxiliary requests as filed on 10 June 2003.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani